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09/747,219	12/18/2000	Alejandro Wiechers	10001310-1	3213

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EXAMINER	
CHEN, TE Y	

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2161	

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EXAMINER

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Commissioner for Patents

Please find an attached copy of the Examiner Answer signed by the the examiner.

Leslie Wong
Primary Examiner

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BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Application Number: 09/747,219
Filing Date: December 18, 2000
Appellant(s): WIECHERS, ALEJANDRO

Alejandro Wiechers
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed July 20, 2006 appealing from the Office action mailed February 27, 2006.

(1) Real Party in Interest

A statement identifying the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

A statement identifying the related appeals and interferences, which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

6522770	Seder et al.	02/18/2003
6,327,594	Van Huben et al.	12/04/2001

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the

applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1, 3-4, 7-8, 21-22 and 25 are rejected under 35 U.S.C. 102(e) as being anticipated by Seder et al. (U.S. Patent No. 6,522,770).

As to claim 1, Seder discloses an electronic document coding system [Abstract, col. 1, lines 16-67], comprising:

a) a reference repository [e.g., the database 18, Fig. 1 and associated texts], wherein, the reference repository receives the electronic file and its characteristic information [e.g., an Watermark at col. 2, lines 40-46 or meta-data at col. 2, lines 60-65 or the embedded Hyperlink of a Web page at col. 4, lines 15-20] from the communication network [e.g., the XYZ network at col. 45-48] and stores the characteristic information in a memory [e.g., col. 3, lines 6-9, 32-34; col. 6, lines 29-30].

b) an indexing unit linked with the reference repository for assigning an identification code to the electronic file based on the associated characteristic data [e.g., col. 2, lines 39-65; the database 18 at col. 5, lines 5-14; the watermark payload technique at col. 6, lines 21-45] wherein, the marking including assigning an existing inventory code [e.g., the UID code at col. 1, lines 38-50; the bar code at col. 7, lines 15-19] and compiles the identification code for the electronic files from the classification code and the inventory code via steganographic and indirect encoding algorithms [e.g., col. 2, lines 47- col. 3, lines 2; col. 7, lines15-19].

c) an editing unit linked with the reference repository and the indexing unit, wherein, the editing unit insert the identification code to the electronic file [e.g., col. 4, lines 8-50].

As to claim 3, except all the limitations recited in claim 1, Seder further discloses that the system communicates via Internet [e.g., col. 3, lines 39-45].

As to claim 4, except all the limitations recited in claim 1, Seder further discloses that the system electronic files comprise published material [e.g., paper documents at col. 1, line 12].

As to claim 7, except all the limitations recited in claim 1, Seder further discloses that the system indexing unit assigns the identification code to the electronic file with respect to the characteristic information [e.g., the watermark payload technique at col. 6, lines 21-45].

As to claim 8, except all the limitations recited in claim 7, Seder further discloses that the system stores the identification code with respect the characteristic information [e.g., col. 3, line 6-38].

As to claim 21, this claim recites the same features as claim 1 in method with broader scope, hence is rejected for the same reason.

As to claim 22, except all the limitations recited in claim 21, Seder further discloses that the electronic file represents a publication [e.g., publication objects at col. 4, lines 15-18], and the characteristic information includes author, the number of pages of the publication, etc. [e.g., col. 1, lines 35-37].

As to claim 25, this claim recites the same feature as claim 22 in form of system, hence is rejected for the same reason.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 9, 11-12, 14, 23-24 and 26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Seder et al. (U.S. Patent No. 6,522,770) in view of Van Huben et al. (U.S. Patent No. 6,327,594).

As to claim 9, Seder discloses an electronic document coding system [Abstract, col. 1, lines 16-67], comprising:

a) a reference repository [e.g., the database 18, Fig. 1 and associated texts], wherein, the reference repository receives the electronic file and its characteristic information [e.g., an Watermark at col. 2, lines 40-46 or meta-data at col. 2, lines 60-65 or the embedded Hyperlink of a Web page at col. 4, lines 15-20] from the communication network including Internet [e.g., the XYZ network at col. 45-48] and stores the characteristic information in a memory [e.g., col. 3, lines 6-9, 32-34; col. 6, lines 29-30]. Seder further discloses that the electronic file comprises published material [e.g., a printable page at col. 4, lines 55-63; any printable object at col. 6, lines 17-20].

b) an indexing unit linked with the reference repository for assigning an identification code to the electronic file based on the associated characteristic data [e.g., col. 2, lines 39-65; the database 18 at col. 5, lines 5-14; the watermark payload technique at col. 6, lines 21-45] and software procedures [e.g., the steganographic encoding algorithm at col. 1, line 38-40; the database management modules at col. 3, line 14-20] wherein, the index marking including using an existing inventory code [e.g., the UID code at col. 1, lines 38-50; col. 7, lines 15-19] and compiles the identification code for the electronic files from the classification code and the inventory code via steganographic and indirect encoding algorithms [e.g., col. 2, lines 47- col. 3, lines 2; col. 7, lines15-19].

c) an editing unit linked with the reference repository and the indexing unit, wherein, the editing unit insert the identification code to the electronic file [e.g., col. 4, lines 8-50].

Seder did not specifically disclose that the software encoding procedures are library-specific.

However, Van Huben et al. (hereinafter referred as Van Huben) discloses the software procedures are library-specific [e.g., Abstract, lines 3 –28; col. 5, line 30 – col. 6, line 30].

Seder and Van Huben are both in the same field of endeavor to code/encode internet objects via scalable software programs [e.g., Seder: col. 1, lines 38-67; VanHuben: col. 5, lines 39-60], therefore, with the teachings of Seder and Van Huben in front of him/her, an ordinary skilled artisan at the time the invention was made would be motivated to apply Van Huben library specific-procedures to modify Seder's system, for the purpose to construct more centralized library specific programs for coding the electronic files of the system such that the combined system will integrate the various types of coding programs to facilitate the centralized control for coding, scaling and tracing of a specific library operation as suggested by Van Huben [Van Huben: col. 5, lines 9-20].

As to claim 11, except all the limitations recited in claim 9, the combined system of Seder and Van Huben further discloses that the editing unit formats the identification code as authorized by the library [e.g., Van Huben: the units: 91, 93 processing, Fig. 9].

As to claim 12, except all the limitations recited in claim 9, the combined system of Seder and Van Huben further discloses a review unit linked with the indexing unit for facilitating the reviewing of formatted electronic file [e.g. Seder: the printer driver monitor at col. 4, lines 32-40].

As to claim 14, except all the limitations recited in claim 12, the combined system of Seder and Van Huben further discloses that the review unit dispatches the formatted electronic file to form a book on demand client machine [e.g., Seder: col. 4, lines 41 – 53].

As to claim 23, this claim recites the same features as claim 9 in form of method with broader scope, hence is rejected for the same reason.

As to claim 24, the combined system of Seder and Van Huben further discloses that the electronic file represents a publication [e.g., Seder: publication objects at col. 4, lines 15-18], and the characteristic information includes author, the number of pages of the publication, etc. [e.g., Seder: col. 1, lines 35-37]

As to claim 26, this claim recites the same features as claim 24 in form of system, hence, is rejected for the same reason.

(10) Response to Argument

Applicant's arguments filed on July 20, 2006 have been fully considered but they are not persuasive.

For independent claims 1 and 21: Examiner disagrees with Appellant's piecemeal interpretation and arguments against the 35 U.S.C. § 102(e) rejections on record. The arguments are summarized as following:

The Seder et al. patent fails teach or suggest:

1) coding an electronic file, more specifically, assigning a classification code to an electronic file based on characteristic information associated with the electronic file;

2) assigning an inventory code to the electronic file based on whether the electronic file already exists in the system;

3) compiling an identification code for the electronic file from the classification code and the inventory code;

4) inserting the identification to the electronic file.

In reply to these arguments: Examiner first noted that appellant does not specifically define the metes and bounds of the claimed "characteristic information associated with the electronic file", thus, any properties associated with an electronic file is considered by the examiner as the claimed characteristic information associated with the electronic file.

Moreover, the examiner respectfully points out that Seder et al. clearly discloses a document management system [e.g., Abstract, col. 1, lines 16-17] which includes software application to steganographic encoding of the document and update the database for a printable electronic document (or web page) [e.g., col. 1, lines 27-31]. Seder et al. further discloses "In accordance with one embodiment of the invention, a steganographic watermark is added to a document at the time of printing." [e.g., col. 2, lines 11-13], wherein, "the software application steganographic encoding of a page" reads on the claimed "coding an electronic file" and "the steganographic encode of a UID" or "the adding of a watermark" to a print page reads on the claimed "assigning a classification code to the claimed electronic file", because an "UID" and "a watermark" are deemed to represent a unique classification code for distinguishing one electronic file from others.

In addition, Seder et al. clearly discloses assigning an inventory code to the electronic file based on whether the electronic file already exists in the system, for example, he discloses an electronic file marking technique can be implemented by steganographically assigning a Unique Identifier (UID at col. 1, lines 27-31) or bar code (at col. 7, lines 15-19), wherein, "the marking of a UID/bar code to an electronic file" reads on "assigning an inventory code to the electronic file" as claimed.

Except using an application software to directly steganographic encoding an identification code for an electronic document as direct data encoding, Seder et al. further discloses indirect data encoding which applies the application payload including classification code and the inventory code as an index into another data repository in which large collections (or compiling) of data can be stored as meta data and thereby, identifiers are issued sequentially with each document assigned a unique identifier. (e.g., col. 2, lines 39-65).

Furthermore, as discussed above the "adding of a watermark" or "encoding an unique identifier" to an electronic file are deemed to inserting the identification to the electronic file as claimed. In addition, Seder et al. discloses a decode software which can be used to edit these information (e.g., col. 3, lines 21-67).

Therefore, base on the discussion above, Examiner concludes that features in claims 1 and 21 are fully anticipated by Seder et al.

For independent claims 9 and 23: these claim are currently rejected under 35 U.S.C. § 103(a), since Appellant fails to provide any specific argument to overcome the prior art rejections on record, hence, the examiner maintains her rejection position.

For the above reasons, it is believed that the rejections should be sustained.

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

Respectfully submitted,

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Examiner
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Conferees:

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